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MSK.P-038-2

PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Rosen et al.

Serial No.: 09/960,665

Filing Date: 09/21/2001

For: Methods and Compositions for Degradation and/or Inhibition of HER-
Family Tyrosine Kinases

Examiner: B. Kifle

Art Unit: 1624

RESPONSE AFTER FINAL REJECTION

Asst. Commissioner for Patents

Washington, D.C. 20231

Sir:

This is in response to the Official Action mailed May 21, 2003 for the above-captioned application. Reconsideration of the application in view of the remarks herein is respectfully requested.

Claims 1, 2, 6, 7 and 12-40 are in this application.

The Examiner rejects the claims under 35 USC § 112, second paragraph, asserting that "it is unclear where in the geldanamycins the linker is bonded to. Is it on the same position on each geldanamycin or can it be bonded on different locations on each." As previously observed, the law relating to definiteness imposes a very specific burden on the Examiner to establish that a person skilled in the art would be unable to understand the scope of the claim when it is read in light of the specification. *Ex Parte Cordova*, 10 U.S.P.Q. 2d 1949, 1952 (POBAI 1989). This burden is not met merely by stating that the claim may encompass several different embodiments, in the absence of any argument or reasoning that such a scope is

I hereby certify that this paper and any attachments named herein are transmitted to the United States Patent and Trademark Office, Fax number: 703-872-9307 on July 21, 2003.

Marina T. Larson
Marina T. Larson, PTO Reg. No. 32,038

July 21, 2003
Date of Signature